

REMARKS

Summary of Amendments

Upon entry of the present amendment claims 7, 11-13, 21, 22 and 24-37 will be pending, with claims 7 and 24 being independent claims. Claim 24 is (editorially) amended, claims 8-10, 14-20 and 23 are canceled and new claims 27-37 are added. Support for the new claims can be found throughout the present specification and in the canceled claims.

Applicants emphasize that the cancellation of claims 8-10, 14-20 and 23 is without prejudice or disclaimer to the prosecution of these claims in one or more continuation and/or divisional applications.

Summary of Office Action

As an initial matter, Applicants note with appreciation that a signed and initialed copy of the Form PTO-1449 submitted in the Information Disclosure Statement filed April 6, 2004 has been returned together with the present Office Action.

Applicants also note with appreciation that the Office Action acknowledges the claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f) and receipt of the certified copy of the priority document.

Claims 9 and 10 are objected to under 37 C.F.R. § 1.75(c), as being of improper dependent form for allegedly failing to further limit the subject matter of a previous claim.

Claims 7, 8 and 11-26 are rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as claims 1, 16, 3-15 and 22-24 of U.S. Patent No. 6,689,228 B2 to KÖCK et al. (hereafter “KÖCK”).

Claims 9 and 10 are rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as claims 1 and 16 of KÖCK.

Response to Office Action

Withdrawal of the objections and rejections of record is respectfully requested, in view of the foregoing amendments and the following remarks.

Response to Objection to Claims 9 and 10

Claims 9 and 10 are objected to under 37 C.F.R. § 1.75(c), as being of improper dependent form for allegedly failing to further limit the subject matter of a previous claim. The rejection asserts that these claims fail to further limit independent apparatus claim 7, because the features recited in claims 9 and 10 allegedly are inherent in the device of independent claim 7.

Claims 9 and 10 are canceled, wherefore this objection is moot. However, Applicants point out that the cancellation of claims 9 and 10 is not to be construed as Applicants' admission that the present objection is justified, but merely is to expedite the issuance of a patent on the claims submitted herewith.

Response to Rejection of Claims under 35 U.S.C. § 101

Claims 7, 8 and 11-26 are rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as claims 1, 16, 3-15 and 22-24 of KÖCK, and claims 9 and 10 are rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as claims 1 and 16 of KÖCK.

This rejection is respectfully traversed. Initially, Applicants note that claims 8-10, 14-20 and 23 are canceled, wherefore this rejection with regard to the canceled claims is moot. However, Applicants point out that the cancellation of claims 8-10, 14-20 and 23 is not to be construed as Applicants' admission that the present rejection is meritorious, but merely is to expedite the issuance of a patent on the claims submitted herewith.

Regarding the rejection of independent claim 7, Applicants respectfully submit that this claim does not recite the same subject matter as any of independent claims 1 and 16 of KÖCK and any of the claims dependent therefrom.

In particular, claim 1 of KÖCK and the claims dependent therefrom recite a device for tempering at least parts of the cross section of sequentially produced profiled rolling stock whereas present claim 7 is directed to a device for tempering at least parts of the cross section of sequentially produced rails. Accordingly, a device that is suitable for tempering the cross section of a certain kind of rolling stock, but cannot be used for tempering the cross section of rails (e.g., because at least one of the dimensions of the device is not large enough for manipulating rails and/or the device is not able to support the weight of rails), literally infringes (at

least) claim 1 of KÖCK, but does not literally infringe present claim 7 or any of the claims dependent therefrom.

With respect to claim 16 of KÖCK it is noted that this claim differs from present claim 7 at least in that the latter claim recites at least two liquid cooling devices, whereas claim 16 of KÖCK recites at least two submersion basins. Accordingly, any device with liquid cooling devices that are different from submersion basins literally infringes (at least) present claim 7, but does not literally infringe claim 16 of KÖCK.

Also the dependent apparatus claims 3-15 of KÖCK relied on in the present rejection do not recite subject matter which can be considered identical to the subject matter of any of the present apparatus claims.

With respect to present independent process claim 24 in comparison to independent process claim 21 of KÖCK, Applicants note that claim 21 of KÖCK is directed to a process for tempering at least parts of the cross section of sequentially produced profiled rolling stock, whereas according to present claim 24, the rolling stock is selected from running rails and railroad rails. Although dependent claim 22 of KÖCK recites that the rolling stock of claim 21 is a rail, it does not specify the type(s) of the rail. Accordingly, a process as recited in present claim 24 which is carried out with a rail which is not a running rail or a railroad rail does not literally infringe claim 24, but literally infringes (at least) claims 21 and 22 of KÖCK.

It also is noted that none of the remaining dependent process claims of KÖCK specifies the type of rail. For at least this reason, all of the present process claims 24-27 are different from claims 22-24 of KÖCK relied on in the present rejection.

To sum up, for at least the reasons set forth above none of the claims submitted herewith is directed to subject matter that is identical to the subject matter of any of the claims of KÖCK relied on in the present rejection. Accordingly, withdrawal of the rejection of the claims under 35 U.S.C. § 101 is warranted and respectfully requested.

CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are in condition for allowance, which action is respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,
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